



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,567	10/22/1999	DAVID BANKS	3676	2060

29855 7590 05/10/2004

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,
P.C.
20333 SH 249
SUITE 600
HOUSTON, TX 77070

EXAMINER

HARPER, KEVIN C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 05/10/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

SC

Office Action Summary	Application No. 09/426,567	Applicant(s) BANKS ET AL.	
	Examiner Kevin C. Harper	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6, 12, 13, 24, 25, 29, 34-36, 44, 45 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6, 29, 34-36, 44 and 47-50 is/are allowed.
- 6) ☒ Claim(s) 12, 13, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claim 12-13 have been considered but are moot in view of the new ground(s) of rejection. The indicated allowability of claim 12 is withdrawn under further consideration of Berman. The indicated allowability of claim 13 is withdrawn in view of the newly discovered reference(s) to Wolff (US 2003/0126200).

2. Applicant did not respond to the double patenting rejection of claims 12-13 and 24-25. Applicant appears to have made a bona fide attempt to advance the prosecution of the application. Because there are new grounds of rejection, the previous double patenting rejections are repeated below.

Claim Objections

3. Claims 25 and 45 are objected to because the definition of the first configuration only changes when the first fabric and the second fabric are compatible (page 20, third and fourth paragraphs). Examiner suggests in claims 25 and 45 replacing the last seven lines ("responsive to a merging...segmenting the second fabric from the first fabric") with --determining whether the definition of the first configuration is compatible with definitions for configurations for the second fabric; responsive to a determination of compatible configurations, modifying the definition of the first configuration to account for the second fabric; and responsive to a determination of incompatible configurations, segmenting the second fabric from the first fabric." Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 12-13 and 24-25 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 and 30-31 of copending Application No. 10/059,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7-10 and 30-31 recite or have inherent all the limitations of claims 12-13 and 24-25 the present invention, except for additionally reciting blocking communications between devices not in a common zone. Claims 12-13 and 24-25 merely broaden the scope of the claims of the '753 application by eliminating elements and their functions from the claims. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite blocking packets as a way for restricting communications between devices not of a common zone.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Berman (US 2003/0095549).

5. Berman discloses a method for use in a system comprising a first fabric (Figure 10; abstract, lines 1-5; para 190) and several devices coupled to the fabric by Fibre Channel connections (para. 183, lines 4-5). The method comprises accessing a definition of a first configuration including at least one zone in an inherent storage medium (para. 8, lines 1-3 and last three lines; paras. 15 and 19) having at least one member and restricting communications between the devices coupled to the first fabric (para. 8, last three lines; para. 24, lines 1-3; para. 30; para. 156). The communication uses the Fibre Channel communications protocol.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berman (US 20030095549) in view of Wolff (US 2003/00126200).

6. Berman discloses a method for use in a system comprising a first fabric (Figure 10; abstract, lines 1-5; para 190) and several devices coupled to the fabric by Fibre Channel

Art Unit: 2666

connections (para. 183, lines 4-5). The method comprises accessing a definition of a first configuration including at least one zone in an inherent storage medium (para. 8, lines 1-3 and last three lines; paras. 15 and 19) having at least one member and restricting communications between the devices coupled to the first fabric (para. 8, last three lines; para. 24, lines 1-3; para. 30; para. 156). Information is read from disks and transmitted across the fabric (para. 183; paras. 70-71; Figure 1). However, Berman does not disclose that the type of communication is read-only access of the disks. Wolff discloses that users access RAID disks in a read-only fashion (Figure 1C; para 214; Figure 13, fields 1392 and 1384). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a read-only access communication in the invention of Berman in order to prevent unauthorized users from writing to storage media.

Allowable Subject Matter

7. Claims 4-6, 29, 34-36, 44 and 47-50 are allowed.
8. Claims 45 would be allowable if rewritten to overcome the a above claim objections.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "SAN Switch Zoning Reference Guide" (pages 1-2, 2-3, and 4-6) and the Vertias press releases each disclose zones for use in a Fibre Channel system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 703-305-0139. The examiner can normally be reached weekdays, except Wednesday, from 9:30 AM to 8:00 PM ET.

Art Unit: 2666

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 703-308-5463. The centralized fax number for the Patent Office is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office for TC 2600 at 703-306-0377.

Kevin C. Harper



May 1, 2004

Seema S. Rao
SEEMA S. RAO 513104
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600